APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,553	10/18/2000	Michael G. Coutts	8573.00	3877

7590   04/08/2004

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EXAMINER
PATEL, HARESH N

ART UNIT	PAPER NUMBER
2154	-4

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 October 2000_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-16_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-16_ is/are rejected.
7)☒ Claim(s) _1, 11_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _18 October 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☒ None of:
        1.☒ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
            application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-16 are presented for examination.

Priority

2.   Acknowledgment is made of applicant's claim for foreign priority based on an application

filed in Europe on 10/21/1999. It is noted, however, that applicant has not filed a certified copy

of the foreign priority application as required by 35 U.S.C. 119(b).

Specification

3.   The disclosure is objected. Some of the informalities are:

        i.   The section "CROSS-REFERENCE TO RELATED APPLICATIONS" is

        missing foreign priority application, co-pending applications and related arts.

        ii.   The "Field of the Invention" sub-section of the "BACKGROUND OF

        THE INVENTION" is missing.

        Appropriate correction is required.

4.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

        The following title is suggested: "Hosting a third party application of the remote server

on a self-service terminal".

Claim Objections

5.   Claims 1 and 11, are objected to because of the following informalities:

Claim 1 mentions, "a link to a remote server storing a server application for issuing to the terminal application requests for using the user interface". It is not clear who is storing a server application and where the server application is being stored. Also it is not clear who is issuing terminal application requests. For examine purpose, examiner considers that the server application is stored at the remote server and the executing server application is issuing terminal application requests.

Claim 1 mentions, "the server application is able to use one or more facilities". However, without execution, the server application cannot by itself use anything. For examine purpose, examiner considers that the server application is being executed at a self-service terminal.

Claim 11 mentions, "the remote server storing a server application". It is not clear who is storing a server application and where the server application is being stored. For examine purpose, examiner considers that the server application is stored at the remote server.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 2 and 3, are rejected under 35 U.S.C. 112, first paragraph, Single Means Claim.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A

single means claim which covered every conceivable means for achieving the stated purpose was

held nonenabling for the scope of the claim because the specification disclosed at most only

those means known to the inventor.). When claims depend on a recited property, a fact situation

comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for

achieving the stated property (result) while the specification discloses at most only those known

to the inventor.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 1, 11, 13 and 14, are rejected under 35 U.S.C. 102(e) as being anticipated by

Chen et al. 6,195,694 (Hereinafter Chen).

9.   As per claims 1, 11, 13 and 14, Chen teaches a self-service terminal system (e.g., kiosk

machine terminal, abstract) having a terminal application (e.g., kiosk application, abstract) to

host a third party application (e.g., advertisement application, col., 6, lines 7-9) as follows:

> a user interface (e.g., user interface, figure 3);

a plurality of self-service terminals (e.g., several kiosks, abstract), each terminal having a

terminal application (e.g., kiosk application, abstract); and

a terminal application for controlling the user interface (e.g., kiosk machine terminal

supporting web page browsing access, col., 5, line 26 – col., 6, line 44),

a remote server interconnected to the plurality of self-service terminals (e.g., network

connection between kiosks and the server, figure 4), storing a server application (e.g., the server

has one or more application files or configuration sets that the server serves to from one or more

kiosks on the network, abstract),

for issuing to the terminal application requests for using the user interface (e.g.,

advertisement application at the server making requests to the kiosks for displaying

advertisements, col., 5, line 26 – col., 6, line 44),

wherein a user of the terminal is able to access the server application from the terminal

(e.g., at kiosk machine of the shopping mall, a user accessing displayed advertisement

application, col., 5, line 26 – col., 6, line 44),

a third party application flow (e.g., continuous advertisements supported by the

advertisement application, col., 5, line 26 – col., 6, line 44),

to use any peripheral devices incorporated in the terminals (e.g., usage of kiosks

peripherals, col., 5, line 26 – col., 6, line 44),

to select one of a plurality of user interface applications for presentation to a user (e.g.,

selection of applications at the kiosk, col., 5, line 26 – col., 6, line 44),

at least one user interface application being controlled by the owner of the terminal (e.g.,

a person configuring application at the kiosk machine, col., 5, line 26 – col., 6, line 44),

at least one user interface application being controlled by a third party (e.g., a person configuring application from the remote server for the kiosk machines, col., 5, line 26 – col., 6, line 44),

monitoring the server application for requests to use facilities controlled by the terminal application (e.g., server determining which other application files to be sent to the kiosk by monitoring the applications supported, col., 7, lines 26 – 46),

the server application is able to use one or more facilities provided by the user interface (e.g., advertisement application supported graphical user interface providing support to sound, video conferencing etc through the peripherals of the kiosks on the network, col., 5, line 26 – col., 6, line 44).

10.   As per claims 2-10, 15, Chen teaches the following:

the user interface includes user input means, a display, and at least one other peripheral device (e.g., terminal input device, display, a printer, col., 4, lines 29-54),

means for receiving files conforming to a page description language (e.g., HTML, col., 3, lines 41-44),

the server application is executed on the remote server (e.g., advertisement application running at remote server, col., 5, line 26 – col., 6, line 44),

the server application is executed on the terminal (e.g., advertisement application running at kiosk machine, col., 5, line 26 – col., 6, line 44),

the remote server implements session tracking to maintain an association between the server and the terminal (e.g., In other preferred configurations of the kiosk 100/200, a

collaboration session is set up between one or more kiosk users and one or more agents of the application provider, the server 195 provides the kiosk with application files 175 that are used to monitor or maintain the kiosk, col., 7, lines 18-25),

the remote server provides a session object for each terminal, so that the session object maintains information about the application flow being executed by that terminal (e.g., Depending on the service providers' application, a real-time collaborative session can also be started with video, audio, shared screen and remote device control functions (see patent to Fin et al.) The embedded program would invoke related API functions 640 to handle video, audio and data communication, col., 15, lines 16-54),

the terminal application monitors the terminal usage during operation of the third party application to ensure that the user is still present, monitoring the user's interaction with the server application to detect absence of the user (e.g., one or more of the embedded control programs 620 in these embodiments monitor the operating status of one or more of the input/output devices 130, e.g. by using "dead man" timer status, error checking protocols, etc. col., 7, lines26 – 46),

the terminal provides a port to which the server application can send requests (e.g., network connection port, figure 1),

the terminal provides the server with a response indicating the status of a request (e.g., One application example of using this kiosk control mechanism is to inquire the system setup and status before the application decides how to configure the kiosk, col., 12, lines 1 – 44).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of

Muftic 5,850,442 (Hereafter Muftic).

13.   As per claim 12, Chen discloses the claimed limitations as above rejected claim 11.

However, Chen does not specifically mention about the use of an authorization server operable

to authorize transactions requested by users. Nonetheless, the concept of authorizing the user

request has been clearly taught by Chen. It is well-known in the art, for example, Muftic teaches

the use of an authorization server operable to authorize transactions requested by users (e.g., at

least one application/information server receives information from the at least one security server

concerning whether the user is authorized and allows the particular electronic commerce

transaction to take place if the user is authorized, col., 25, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine the teachings of Chen with the teachings of Muftic in order to facilitate a

server to authorize user requests made from the network terminals. The user requests to access

the remote server will be first verified by the authorizing server to provide secure transactions

between the user and the server supporting the user requests, as suggested by Muftic.

14.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of

"Official Notice".

15.   As per claim 16, Chen discloses the claimed limitations as above rejected claims 14 and

15. However, Chen does not specifically mention about halting the server application and

presenting the terminal application. Nonetheless, the concept of using both the advertisements

application and the terminal applications at the kiosk machine has been clearly taught by Chen.

"Official Notice" is taken that both the concept and advantages of halting the server application

and presenting the terminal application is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to include about halting the server application and presenting the terminal application

with the teachings of Chen to facilitate switching the use of the server application to the terminal

application when the user no longer uses the self-service terminal. After the existing user is done

accessing the self-service terminal, the server application will stop displaying the user interface

specific to the existing user. The terminal application will start displaying the user interface

containing common user interface screens that can be used by the next user.

Conclusion

16.   Examiner makes a very clear note that the rational of the applicant's invention has been

clearly anticipated by Chen and Muftic.

17.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The

examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to

8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or

proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

April 1, 2004

ZARNI MAUNG
PRIMARY EXAMINER